

**REMARKS**

Claims 1 through 59 are pending in the application. Claims 44, 55, and 58 are amended in minor particulars.

**Presentation of Claims**

In paragraph 1 of the Office action, the Examiner requested a set of “clean version of the claims of the present application.

It is respectfully submitted that a clean version of amended claims is required in accordance with 37 C.F.R. §1.121(c)(1)(i), and that the first paragraph of 37 C.F.R. §1.121(a) clearly states that the amendments under that section are for *other than reissue applications*. The Examiner's attention is respectfully invited to the fact that the instant application is a *reissue* application, and that, per 37 C.F.R. §1.121(h), any amendment to the description and claims in *reissue* applications must be made in accordance with **§1.173**. 37 C.F.R. §1.173(b)(2) states,

“An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. ....Each changed patent claim and each added claim **must include markings pursuant to paragraph (d)** of this section, except that a patent claim or added claim should be canceled by a statement cancelling the claim without presentation of the text of the claim.” (emphasis supplied)

37 C.F.R. §1.173(d) states,

“Any changes **relative to the patent being reissued** which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, **must include** the following markings:

- (1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, ... .”  
(emphasis supplied)

As is clearly explained above, a clean version of the claims of the reissue application is not required by filing of an Amendment for a reissue application; the rule only requires showing of the changes made by filing of an Amendment.

Furthermore, in a Letters Patent for a reissue application, the specification, including the claims will be printed in such a manner as to show the changes over the original patent text by enclosing any material omitted by the reissue in heavy brackets and printing material added by the reissue in italics. Accordingly, a clean version of amended claims will destroy the aforesaid purpose.

However, per the Examiner's express request, Applicant is presenting herewith a “clean version” of pending claims including the claims amended by this Amendment. Note however, brackets for omission and underlines for addition are retained in the original claims 1 through 8, and underlines remain for the newly added claims 9 and above. The marked-up version of the claims is presented at the end of the Amendment.

#### Declaration

In paragraph 2 of the Office action, the Examiner rejected claims 1 through 59 under 35 U.S.C. §251 for a defective reissue declaration. In response, substitute Declarations containing claim of foreign priority executed by the assignee and the inventor are submitted concurrently with this Amendment.

#### Drawings

In paragraph 3 of the Office action, the Examiner stated with respect to the drawings that “It

is regretted that the transfer of drawings from the parent files as was requested earlier is no longer permitted and that new drawings must now be submitted."

Applicant is submitting a copy of each drawing sheet of the originally printed patent, U.S. Patent No. 5,719,618, Figs. 1 through 4 (5 sheets).

**Claim Rejection Under 35 U.S.C. § 112**

In paragraph 4 of the Office action, the Examiner rejected claims 44 through 47 and 55 under the second paragraph of 35 U.S.C. §112 for alleged indefiniteness.

**Claim Rejection Based Upon Recaptured Subject Matter**

In paragraph 5 of the Office action, the Examiner rejected claims 20, and 44 through 58 for alleged recaptured subject matter. Applicant respectfully traverses this rejection for the following reasons.

Claims 9 through 19 and 29 through 58 were newly rejected as being drawn to recaptured subject matter. The Examiner cited the *Pannu v. Storz Instrument, Inc.*, Fed. Cir. 00-1482, 7/25/2001 (decision). Applicant respectfully traverses this rejection for the following reasons:

As was earlier explained, the seminal judicial decision of *Pannu v. Storz Instrument, Inc.*, Fed. Cir. 00-1482, 7/25/2001 (decision) refers to U.S. Patent No. 4,436,855 (the Examiner's attention is drawn to the fact that the decision of the Court is incorrect, and that the Pannu '855 is actually U.S. Patent No. 4,435,855) and Re32,525. All claims in the '855 patent define the haptics as having "a continuous, substantially circular arc having a diameter greater than the diameter of the lens body," while claims 1 through 10 in the '525 reissue patent deleted this limitation. There were no other

independent claims in the '855 Pannu patent; consequently, *all* claims contain the same limitation. In view of the amendments of all claims to add the “two flexible and supporting elements” and the accompanying arguments presented by Pannu during prosecution of the '855 patent, the Court properly held that an attempt to obtain a broader definition of the haptics constituted a recapture of subject matter surrendered during the prosecution of the '855 patent.

A similar result may be found in *Hester Industries Inc. v. Stern Inc.*, 64 USPQ2d 1641 (Fed. Cir. 1998) where all of the original claims defined cooking “solely with steam” supplied by “two sources of steam”, which limitations were deleted from the reissue patent. There, the Court properly held that the reissue patent was invalid.

In the instant application however, the Examiner has focused upon Applicant's “system power stand-by state” as defined by issued independent method claims 7 and 8, and has asserted that the absence of this limitation from the rejected claims constitutes impermissible recapture. The Examiner has ignored however, the fact that independent method claim 1 defines not the “system power stand-by state” of claim 8, but instead defines simply a “stand-by mode of operation” while independent apparatus claim 2 defines a “stand-by mode of operation.”

The rejected claims also define a “stand-by mode of operation” as opposed to the “system power stand-by state” of claim 8 argued by the Examiner. In view of the fact that claims 1 through 7 were not addressed by the Board of Patent Appeals and Interferences and were not the subject matter of the arguments presented by Applicant for patentability of claim 8, there is no basis for arguing recapture. Withdrawal of this rejection is therefore required.

Moreover, and most significantly, Applicant never argued non-obviousness before the Board

of Appeals in the parent application. *See*, for paragraph 8 of the Board's findings, where the Board wrote "Curiously, Applicant does not challenge the examiner's rejection for obviousness in his brief." The Board continued however, by finding that the Examiner simply had not met "the burden of establishing unpatentability by a preponderance of the evidence." Absent challenge by Applicant then, there is no basis for the Examiner to now assert recapture. The rejections for recapture are unfounded on the record, and must be withdrawn.

**Procedure for Determination of Recapture**

The Examiner's attention is invited to the reasoning of the Court in the *Pannu* decision, where the Court explains that the application "of the recapture rule is a three step process. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Finally, the Court must determine whether the reissue claims were materially narrowed in other aspects to avoid the recapture rule. These three steps are set forth in the *Manual of Patent Examining Procedure*, §1412.02 (8<sup>th</sup> ed.).

As explained in the *Manual*,

"If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable *over a rejection or objection* made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists." §1412.02

The Examiner has confused the arguments presented on behalf of patentability of what is now claim 8, with prosecution of what are now claims 1 through 7. Independent method claims 2 and 9 were

presented in Applicant's Preliminary Amendment filed on 1 March 1993, together with independent apparatus claims 3 and 5 (now claims 2 and 4). The issues raised by the Examiner about *standby state* were raised by Applicant in an unanswered Petition under 37 C.F.R. §1.181 filed on 12 January 1994 and an unanswered renewed Petition under 37 C.F.R. §1.181 filed on 17 February 1994. It is disingenuous for the Examiner to now raise these issues, when the original Petitions remain unanswered by the Director.

Moreover, independent method claims 2 and 9, which are now patented method claims 1 and 8, were never amended and were never argued as being distinguishable over the art due to the presence of "during said power standby mode". Similarly, independent apparatus claims 3 and 5 (now patented claims 2 and 4) were neither amended nor argued to either include or as distinguished over the art due to the presence of the limitation "during a system power standby state." This limitation was present in originally drafted claim 8 filed on 10 May 1993, and was neither amended to avoid art or to otherwise obtain allowance of claim 8, simply because this limitation was never amended and it was the Board, rather than the Examiner, who allowed claim 8. Consequently, the first step applied in recapture rule, that is, identifying a limitation that "was originally presented/argued/stated in the original application to make the claims allowable over a rejection made in the original application", is wholly absent here. MPEP §1412.02.

#### Arguments Made During Prosecution

Furthermore, Applicant has surrendered nothing during the prosecution of the parent application. As explained in §1412.02,

"argument (without amendment to the claims) in the original application may

be sufficient to establish recapture."

Here, Applicant never argued the phrase "during the system power standby state" in conjunction with the allowance of independent apparatus claims 3 and 5 (now claims 2 and 4) simply because that limitation is not present in these apparatus claims. Moreover, Applicant never argued this limitation in conjunction with the allowance of independent method claims 2 and 9 (now claims 1 and 8), as is evident in the Remarks of Applicant's Amendment filed on 30 June 1994. It was the subsequent Office action, and the Advisory Action dated 8 July 1994 that allowed claims 2 through 7 and 9. With exception of one issue under the second paragraph of §112 pertain to claim 3, the Remarks in that Amendment were directed to patentability of claim 8, which was subsequently allowed by the Board. Applicant's unanswered Petitions of the 12 January 1994 and 17 February 1994 dealt with the procedure followed by the Examiner, and presented neither arguments nor amendments of subsequently allowed claims 2 through 7 and 9. The Examiner's attention is directed to pages 9-11 of Applicant's long unanswered Petition of 17 February 1994, where claims 2 through 7 and 9 were discussed. The word "standby" does not appear anywhere in these discussions. No amendments of these claims were made to add any limitation of "standby". Similar arguments are set forth in pages 8-10 of Applicant's earlier filed, but also long unanswered Petition dated 12 January 1994. In view of the failure and refusal of the Group to timely respond to these Petitions, there is no basis for the Commissioner to now raise those issues. In short, there is neither surrender nor demonstration of the absence of the third step required by the *Pennu* decision, namely, a determination of whether the reissue claims are materially narrowed in other respects so as to avoid the recapture rule. In short, the rejection is incomplete and improper on both the amendments presented during the prosecution

of the parent claims and the arguments presented for patentability of those claims.

**Relation Between Patented and Rejected Claims**

The Examiner has argued that claim 20 can only relate to patented claim 7, and method claims 44-58 may only be related to patented claims 7 and 8. The Examiner has no authority to make this assertion, and there is no showing that these claims are not also related to patented apparatus claims 2 and 4.

The Examiner questions whether claim 20 should expressly state that Applicant's step of "making a subjective evaluation" is "being done during said system power standby mode" as established by claim 7. Claim 7 lacks Applicant step of "making a subjective evaluation". Consequently, claim 7 does not create any estoppel to Applicant's presentation of claims containing process steps that are not present in claim 7. By way of example, nothing in a doctrine of recapture prevents Applicant from amending claim 7, by way of example, to include Applicant's step of "making a subjective evaluation". Consequently, there is nothing in the doctrine that prevents Applicant from presenting claim 20 with this process step.

The Examiner's attention is invited to the fact that claim 20 does define a step of "during said power standby mode of operation, selectively generating a code". Independent claim 1 defines a method in which "when the video cassette recorder is in said standby mode of operation", the recorder receives "a lack function code". Claim 2 defines a recorder having "a standby mode of operation wherein the video tape is not reproduced" while claim 4 defines a recorder having "a standby mode of operation wherein the video tape is not reproduced." Claim 7 alternatively defines a method of "checking" during "a system power standby mode of operation" for "a key-data input

signal” while claim 8 defines “checking for an input signal, ... during a system power stand-by state.” Nothing in the arguments presented during prosecution, or in limitation added to the claims during prosecution, suggest that Applicant is forbidden from broadly defining an alternative step of “during said system power standby mode of operation, selectively generating a code” as set forth in line 5 of claim 20, in combination with a newly presented step of “making a subjective evaluation”, despite the fact that <sup>no<sup>l</sup>e</sup> <sub>\</sub> of the pending claims expressly use this combination of language. Consequently, there is no basis for refusing allowance of claim 20 simply because Applicant does not expressly define step of making the evaluation during the system power standby mode, when neither the amendments to the claims presented during prosecution of the parent application, or the arguments presented in support of the allowance of those claims, state that the step of “evaluation” occurs “during the system power standby mode of operation.” Withdrawal of this rejection of claim 20 is therefore required.

The Examiner questions whether the arguments presented in the Brief in Applicant’s parent application in support of patentability of claim 8, require that independent claims 44, 48, 55 and 56 expressly recite either a “standby” mode as defined by claim 1 or a “power standby” as defined by claim 7 and 8? The Examiner asserts that reference to apparatus claim 4 as a basis for this reissue process/method claims can not provide a basis for recapture here. Applicant agrees with the Examiner’s assertion. The fact that claims 44 through 58 might be related in various aspects to apparatus claim 4, rather than claim 8 which was ultimately allowed by the Board of Appeals is irrelevant to application of the doctrine of recapture. The Examiner’s question ignores the fact that patented claim 7, rather than patented claim 8, with the subject matter of the Brief, and that the

arguments presented and supported the patentability of patented claim 7 have nothing to do with the patentability of either patented claims 1 through 6 or patented claim 8. The fact that the “standby” mode may have been argued as a point of patentable distinction of patented claim 7, has nothing to do with patentability of apparatus claims 2 and 4, neither of which define specific process steps as occurring during a standby mode of operation. Patented claims 1 through 6 and 8 were allowed prior to Applicant’s presentation of any arguments or remarks directed to the “standby” mode. Consequently, neither the amendments to patented claims 1 through 6 and 8 nor arguments presented in support of patentability of those claims creates a recapture bar to Applicant’s presentation now of reissue process claims that performs certain steps that are not limited to occurrence during a standby mode. This permissible breath of scope according to Applicant’s presentation of process claims conforms to the scope of the patented apparatus claims, which do not limit the operation of particular constituent elements to the occurrence of a standby mode. Withdrawal of this rejection is therefore required.

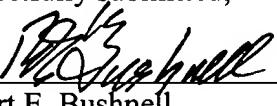
In summary, the foregoing deficiencies in application of the recapture rule, together with the fact that Applicant made no amendment of either patented method claims 1 and 8 or patented apparatus claims 2 and 4 to add any “power standby” limitation, and made no argument to justify patentability of these claims over the applied art, establishes that recapture does not exist. The Examiner is further reminded that claim 8 was the subject of the appeal, and that was the Board, rather than the Examiner who allowed claim 8. Claim 8 however, differs in scope, breadth, and content from these rejected claims, as well as claims 1, 2, 4 and 8. There is no basis therefore, in restricting the consideration of recapture to only patented claims 7 and 8. Withdrawal of the rejectio

is therefore required.

In view of the foregoing explanations and remarks, all claims are deemed to be in condition for allowance. Should any questions remain unresolved however, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,

  
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**MARKED-UP VERSION OF AMENDMENTS**

**IN THE CLAIMS**

Please amend claims 44, 55, and 58, as follows:

1       44. (Amended) A process for locking and unlocking a signal, comprising the steps of:  
2       receiving from a keyboard a first lock key data signal;  
3       generating a first character signal in response to said first lock-key data signal;  
4       generating a video signal reproduced from a recording medium;  
5       mixing said video signal and said first character signal;  
6       displaying on a screen a first image representing said video signal and said first character  
7       signal;  
8       receiving a second lock-key data signal after receiving said first lock-key data signal;  
9       generating a second character signal in response to said second lock-key data signal;  
10      mixing said video signal and said second character signal;  
11      displaying on a screen a second image representing said video signal and said second  
12      character signal;  
13      making a determination of whether said second lock-key data signal is identical to said first  
14      lock-key data signal;  
15      locking said video signal and preventing application of said video signal to [said mixer]  
16      enable said mixing in dependence upon said determination.

1       55. (Amended) A process for locking and unlocking a signal, comprising the steps of:  
2       receiving a first lock key data signal;  
3       generating a first character signal in response to [a prompt screen] reception of said first  
4       lock key data signal;  
5       receiving a video signal;  
6       mixing said video signal and said first character signal;  
7       receiving a second lock key data signal;  
8       generating a second character signal in response to second lock key data signal;  
9       mixing said video signal and said second character signal;  
10      making a determination whether said second lock key data signal is identical to a reference;  
11      and  
12      locking and unlocking said [audio signal and] video signal in dependence upon to said  
13      determination by preventing said mixing of said video signal during said locking and permitting said  
14      mixing of said video signal during said unlocking.

1       58. (Amended) The process of claim 56, further comprised of the steps of:  
2       making a determination of whether said second lock-key signal is identical to a reference;  
3       generating an error message signal in accordance with said determination when said second  
4       lock-key signal is not identical to said reference;  
5       mixing said character signal and said error message signal; and  
      displaying an error image representing said character signal and said error message signal.